THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ARTHUR R. STEITZ
Junior Party,[1]

v.

ROBERT L. BENTLEY
Senior Party.[2]

Patent Interference No. 103,669

Before PATE, MARTIN and CRAWFORD, Administrative Patent Judges.

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[1] Application 08/398,967, filed March 2, 1995.

[2] Application 08/349,258, filed December 5, 1994.

PATE, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658

This is a final decision pursuant to 37 CFR § 1.658 in Interference No. 103,669. The subject matter is directed to a tool for manually loading cartridges in a firearm magazine. The tool consists of a band sized to encircle the wearer's thumb and a projection extending from the band for engaging a cartridge already present in the magazine.

The count in interference reads as follows:

> A device for manually loading cartridges into a magazine which is adapted to receive a plurality of cartridges in stacked relation there within [sic] said magazine having an opening for receiving said cartridges and means for biasing said cartridges toward said opening, said device comprising:
>
> a band configured in size and shape for placement on a thumb of one hand for loading said magazine with said cartridges when said magazine is gripped by said one hand, and a projection integrally associated with said band and extending from an outer surface of said band for engagement of a top one of said cartridges previously loaded into said magazine;

> said projection having a surface adapted to contact a surface of said cartridges in such manner as to maintain engagement with said top one of said cartridges when said magazine is gripped by said one hand for depressing said top one of said cartridges away from said opening against said biasing means in response to a bending/depressing thumb motion; whereby another of said cartridges can be manually loaded into said magazine by using the other hand.

The claims of the parties that correspond to the count are:

Steitz	Claims 1-18
Bentley	Claims 2, 18, 20, 21, 27 and 28

The interference was declared on November 19, 1996. Although both parties designated lead attorneys pursuant to 37 CFR § 1.613, the senior party has chosen to stand on his filing date and has not filed any other papers. The junior party filed a preliminary statement, took testimony in the form of declarations, filed a record, and filed a brief for final hearing. The senior party did not request cross-examination and filed no brief. An oral argument at final hearing was waived by the junior party. Accordingly, the sole issue for our consideration is the junior party's priority case.

Burden of Proof

The junior party's involved application was filed during the pendency of the senior party's patent application. Accordingly, for the junior party to prevail in a priority contest, the junior party must prove priority of invention by a preponderance of the evidence. See Peeler v. Miller, 535 F.2d 647, 651 n.5, 190 USPQ 117, 120 n.5 (CCPA 1976). Accord Bosies v. Benedict, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994). Cf. Price v. Symsek, 988 F.2d 1187, 1194, 26 USPQ 1031, 1036 (Fed. Cir. 1993).

The senior party has not put on a case-in-chief. Therefore, the senior party’s date of invention is his actual filing date, December 5, 1994.

Steitz’ Priority Case

Conception has been defined as the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention. Coleman v. Dines, 754 F.2d

353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985) (quoting Gunter v. Stream, 573 F.2d 77, 80, 197 USPQ 482, 484 (CCPA 1978)). It is settled that in establishing conception a party must show every feature recited in the count, and that every limitation in the count must have been known at the time of the alleged conception. Coleman, 754 F.2d at 359, 224 USPQ at 862.

It is equally well established that proof of actual reduction to practice requires demonstration that the embodiment relied upon as evidence of priority actually worked for its intended purpose. Newkirk v. Lulejian, 825 F.2d 1581, 1583, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987).

Finally, it is also well established that every limitation of the interference count must exist in the embodiment and be shown to have performed as intended. Id. See also Scott v. Finney, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994).

Neither conception nor reduction to practice may be established by the uncorroborated testimony of the inventor. See Tomecek v. Stimpson, 513 F.2d 614, 619, 185 USPQ 235, 239 (CCPA 1975). The inventor's testimony, standing alone, is

insufficient to prove conception--some form of corroboration must be shown. See Price, 988 F.2d at 1194, 26 USPQ2d at 1036. While the "rule of reason" originally developed with respect to reduction to practice has been extended to the corroboration required for proof of conception, the rule does not dispense with the requirement of some evidence of independent corroboration. See Coleman, 754 F.2d at 360, 224 USPQ at 862. As the CCPA stated in Reese v. Hurst, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981): "adoption of the 'rule of reason' has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself." There must be evidence independent from the inventor corroborating the conception. Additionally,

we acknowledge that there is no single formula that must be followed in proving corroboration. An evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached. Price, 988 F.2d at 1195, 26 USPQ2d 1037. Independent

corroboration may consist of testimony of a witness, other than the inventor, or it may consist of surrounding facts and circumstances independent of information received from the inventor. Reese, 661 F.2d at 1226 n.4, 211 USPQ at 940-41 n.4.

The following represents our findings of fact with regard to junior party Steitz' inventive acts. The Steitz record is comprised of declarations by inventor Arthur R. Steitz, his wife Rita Steitz, the inventor's son, Matthew P. Steitz, and Ron J. Gales. Inventor Steitz states that he conceived of the invention and disclosed the conception to his wife and son at least by the end of April 1994.[3] SR3.[4] Steitz' wife and son

[3] When an inventor's testimony merely places acts within a stated time period, the inventor has not established a date for his activities earlier than the last day of the period. Oka v. Youssefyeh, 849 F.2d 581, 584, 7 USPQ2d 1169, 1172 (Fed. Cir. 1988).

[4] The Steitz Record will be abbreviated SR followed by the appropriate page number. The Steitz exhibits will be referred to as SX- followed by the appropriate exhibit number.

corroborate this conception date. SR11; SR14. Therefore, we credit Steitz with a corroborated conception as of April 30, 1994.

Steitz further states that he requested that his son make a drawing of the invention, which drawing was completed by at least August 24, 1994. SR3. The drawing is SX-1. The date that this drawing was completed is corroborated by Matthew Steitz, whose initials appear on the drawing near the date. SR3; SR14.

Steitz then constructed a prototype of the invention. The prototype was completed by November 5, 1994. SR3. The prototype is shown in photographs: SX-2, SX-3, SX-4.

Mrs. Steitz corroborates the completion of the prototype and appears in one of the photographs. SR11; SX-2.

Steitz conducted tests of the prototype with the assistance of witness Gales in November, a few days after the prototype was constructed. SR4. Gales confirms the tests were conducted in November and agrees with Steitz that the device worked for its intended purpose. SR17. Based on this

evidence, we credit Arthur R. Steitz with a corroborated actual reduction to practice date of November 30, 1994.

Inasmuch as we have credited junior party Steitz with an invention date prior to the effective filing date of the senior party, and the senior party has relied on his filing date as his date of invention, the junior party has overcome the senior party's date of invention. Judgment will be entered in favor of the junior party.

Judgment

Judgment in Interference No. 103,669 is entered in favor of the junior party, Arthur R. Steitz. Arthur R. Steitz is entitled to a patent containing claims 1 through 18, which claims correspond to the count in interference. Judgment is entered against Robert L. Bentley, the senior party. Robert L. Bentley is not entitled to a patent containing claims 2, 18, 20, 21, 27, and 28, which claims correspond to the count in interference.

WILLIAM F. PATE, III)
Administrative Patent Judge)
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) BOARD OF PATENT
JOHN C. MARTIN) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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MURRIEL E. CRAWFORD)
Administrative Patent Judge)

WFP:psb

Interference No. 103,669

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